

Remarks

Claims 32, 36 and 37 are pending. Applicant appreciates the withdrawal of the previous rejections based on the assertion that the claimed invention lacks patentable utility.

For the newly imposed rejections in the instant Office Action, Applicant respectfully requests reconsideration for at least the following reasons.

Priority

It is asserted in the Office Action that, with respect to the disclosure of SEQ ID NO:8, the instant application is not entitled to priority to provisional application serial no. 60/085,029, filed May 11, 1998.

Applicant respectfully disagrees and believes that priority should be accorded to the filing date of the provisional for the all of the original claims, as well as the presently pending claims.

Applicant responds to the outstanding rejections as follows.

Rejection under 35 U.S.C. 103

All the claims stand rejected based on the contention that they are unpatentable over the reference of Prosnia M, et al. *A novel candidate oncogene, MCT-1, is involved in cell cycle progression*. Cancer Research (October 1, 1998), pp 4233-4237, in view of Young et al. (U.S. Patent No. 6,153,740). The Examiner indicates it would be obvious to make a monoclonal antibody that binds specifically to MCT-1 from the combination of Prosnia et al. and Young et al.

In response, the Examiner's attention is courteously directed to the enclosed declaration under 37 C.F.R. 1.132 from Dr. Ronald Gartenhaus, the inventor on the instant application. As can be seen from Dr. Gartenhaus' declaration, he is an author on the cited Prosnia et al. reference, all of the authors other than Dr. Gartenhaus were working under his supervision, and none of them made an inventive contribution to the invention. In connection with this, it is a well established tenet of U.S. patent law that an Applicant's disclosure of his or her own work within the year before the application filing

date cannot be used against him or her. The Prośniak et al. reference was published in the October 1, 1998 issue of the journal *Cancer Research*. Therefore, even assuming *arguendo* that the instant application is only entitled to the priority of PCT/US99/10184 (May 5, 1999), which is an assumption Applicant does not make, Dr. Gartenhaus' work described in the Prośniak et al. reference was published within one year of the PCT application filing date and cannot now be cited against the instant application. Thus, since the primary reference of Prośniak et al. is no longer citable against the present application, the stated rejection under 35 U.S.C. § 103(a) cannot be maintained. The Examiner is respectfully requested to reconsider and remove the rejection.

Rejection under 35 U.S.C. § 102(e)

All the claims stand rejected based on the assertion that they are anticipated by Edwards et al. (US 6,783,961), which is accorded an earliest effective filing date of February 26, 1999. The Edwards et al. reference does not claim the same invention as in the instant case.

In response to the rejection over Edwards et al., the Examiner's attention is directed to the publication date of Dr. Gartenhaus' work per the Prośniak et al. reference, which is October 1, 2008. As the Examiner has pointed out, the Prośniak et al. reference in Fig. 1 discloses an amino acid sequence that is 100% identical to SEQ ID NO:8. Thus, the Prośniak et al. reference itself establishes that Dr. Gartenhaus was in possession of SEQ ID NO:8 at least as early as October 1, 2008, which is before the 102(e) date of the Edwards et al. reference. Therefore, it is submitted that the Edwards et al. reference should be removed from consideration.

Conclusion

Based on the remarks and the declaration presented herein, Applicant believes all the pending claims are now in condition for allowance and respectfully requests the Examiner to allow all the claims. Applicant request a one-month extension of time to file this response. Any fees may be charged to deposit account number 08-2442.

Respectfully submitted,
HODGSON RUSS LLP

/John D. Lopinski/

By _____
John D. Lopinski, Ph.D.
Reg. No. 50,846

The Guaranty Building
140 Pearl Street, Suite 100
Buffalo, NY 14202-4040
Tel: (716) 848-1430
DATE: October 22, 2009